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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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|---------------------------|--|
| Proceeding | 91214312 |
| Party | Defendant Midway Trading Corp. |
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| Submission | Motion to Amend/Amended Answer or Counterclaim |
| Filer's Name | Rodrick J. Enns |
| Filer's e-mail | renns@ennsandarcher.com, jarcher@ennsandarcher.com |
| Signature | /Rodrick J. Enns/ |
| Date | 03/07/2014 |
| Attachments | Amended Answer and Counterclaim.pdf(18275 bytes) |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application Serial No. 85834409
For the Mark TANDUAY
Published in the *Official Gazette* on July 16, 2013

DIAGEO BRANDS B.V.,

Opposer,

v.

Opposition No. 91214312

MIDWAY TRADING CORP.,

Applicant.

AMENDED ANSWER AND COUNTERCLAIM

Applicant Midway Trading Corp., pursuant to 37 CFR §2.107(a) and Fed. R. Civ. P. 15, and having previously timely filed its Answer To Notice Of Opposition on February 17, 2014, now submits this Amended Answer and Counterclaim, and responds to the Notice of Opposition against the above-referenced trademark application as follows:

1. Applicant admits the allegations in Paragraph 1 on information and belief.
2. Applicant admits that Opposer and its predecessors have used the mark TANQUERAY in connection with gin for a number of years. Applicant is without sufficient knowledge or information to form a belief as to the truth of the remaining allegations in Paragraph 2 and therefore denies the same.
3. Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations in Paragraph 3 and therefore denies the same.

4. Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations in Paragraph 4 and therefore denies the same.

5. Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations in Paragraph 5 and therefore denies the same.

6. Applicant admits that the TESS database on the USPTO website indicates that Opposer is the owner of the cited registrations covering the goods listed by Opposer and claiming the dates of first use as stated. Applicant further admits that the TESS database shows that Opposer has filed Section 15 declarations for each of these registrations.

7. Applicant admits the allegations of Paragraph 7.

8. Applicant admits the allegations of Paragraph 8.

9. Applicant admits that it filed the application for TANDUAY on January 28, 2013, based on use in commerce since March 29, 2012, and that this date is after the claimed first use dates for Opposer's TANQUERAY marks cited in Paragraph 6.

Applicant is without sufficient knowledge or information to form a belief as to the truth of the remaining allegations in Paragraph 9 and, therefore, denies the same.

10. Applicant denies the allegations in Paragraph 10.

11. Applicant denies that dry gin, gin, or vodka are identical to rum, or that any of such goods are sufficiently related to rum as to give rise to a likelihood of confusion in the context of the respective marks. To the extent that the allegations of Paragraph

11 may be read to allege that Opposer has used Opposer's Marks on or in connection with rum, such allegations are also denied. Applicant admits the remaining the allegations of Paragraph 11.

12. Applicant admits the allegations of Paragraph 12 upon information and belief.

13. Applicant denies the allegations in Paragraph 13.

14. Applicant denies the allegations in Paragraph 14.

15. Applicant denies the allegations in Paragraph 15.

16. Applicant denies the allegations in Paragraph 16.

WHEREFORE, Applicant respectfully requests that this Opposition be denied and that Application Serial No. 85834409 be allowed to proceed to registration.

COUNTERCLAIM

(Partial Cancellation pursuant to Lanham Act Section 18, 15 U.S.C. § 1068)

For its counterclaim against Opposer, Applicant hereby alleges the following:

1. Opposer is the owner of record of Registration No. 3,369,110 for the mark TANQUERAY, claiming use on "distilled spirits" in International Class 33 since 1986.

2. Opposer uses the TANQUERAY mark only on gin, and the TANQUERAY STERLING mark only on vodka. Opposer does not use the TANQUERAY mark or any formative thereof on any other distilled spirits.

3. Opposer does not currently use and has never used the mark TANQUERAY on rum.
4. Applicant's pending Application Serial No. 85834409 seeks registration of the mark TANDUAY for "rum."
5. Opposer has asserted its Registration No. 3,369,110 in support of its claim of likelihood of confusion with respect to Applicant's pending Application Serial No. 85834409.
6. Applicant believes and contends that there is no likelihood of confusion between Applicant's mark and Opposer's mark as described in Opposer's cited registrations, including Registration No. 3,369,110. In the alternative, however, should it be determined that there is a likelihood of confusion based on Opposer's Registration No. 3,369,110 of TANQUERAY for "distilled spirits" including rum, such likelihood of confusion will be avoided by a restriction of the goods claimed in Registration No. 3,369,110 to conform to Opposer's actual use, namely, gin and vodka.

WHEREFORE, Applicant respectfully requests pursuant to Lanham Act §18, 15 U.S.C. § 1068, that Opposer's Registration No. 3,369,110 be partially cancelled by restricting or limiting the description of goods therein to "gin and vodka," or alternatively to "distilled spirits excluding rum," so as to correctly reflect Opposer's use, together with such other and further relief as the Board may find appropriate in the exercise of its equitable powers under Lanham Act §18.

Please charge the fee for this Counterclaim for partial cancellation in the amount of \$300, and any other appropriate fees, to Deposit Account No. 501779.

Please direct all correspondence to Julia C. Archer and Rodrick J. Enns at Enns & Archer LLP, 939 Burke Street, Winston-Salem, NC 27101, 336-723-5180, jarcher@ennsandarcher.com, renns@ennsandarcher.com.

Respectfully submitted via ESTTA, this the 7th day of March, 2014.

ENNS & ARCHER LLP

/Rodrick J. Enns/

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CERTIFICATE OF SERVICE

I hereby certify that on this date I served the foregoing AMENDED ANSWER AND COUNTERCLAIM upon counsel of record by depositing a copy thereof in the United States mail, first class, postage prepaid and addressed to:

Evan Gourvitz
Diageo North America, Inc.
801 Main Avenue
Norwalk, CT 06851

This the 7th day of March, 2014.

/Rodrick J. Enns/
Rodrick J. Enns

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